

Serial No.: 10/065,282  
Attorney Docket No.: F-522

Patent

## REMARKS

### 1. Status of Claims

Claims 1-17 were pending in the Application. Applicants have amended claims 1, 3, 4 and 15 without prejudice or disclaimer. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-17 will remain pending in the application.

### 2. Rejections under 35 USC § 103(a)

In section 3 of the Office Action, the Examiner rejected Claims 1-3 and 5-17 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,681,045 B1 to Lapstun, et al. ("Lapstun '045") in view U.S. Patent No. 6,773,177 to Denoue, et al. ("Denoue '177").

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended claims 1, 3 and 15 and the rejection is moot.

Initially, Applicants respectfully submit that the references are not properly combined. Denoue '177 describes printing systems, not pen input systems and one of skill in the art would not look to Denoue '177 to modify Lapstun '045.

Regarding claim 1, Applicants respectfully submit that at least the following elements are not taught or suggested by the cited references:

then receiving processed metadata created using the metadata from the processor; and

then storing the processed metadata in the dynamic read-write metadata storage device that is completely attached to a portion of a surface of the document, wherein the processed metadata includes text data.

For example, the cited reference does not teach or suggest a read-write metadata storage device completely attached to the surface of the document.

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Regarding claim 3, Applicants respectfully submit that the references do not teach or suggest:

wherein the metadata includes a character representation of the captured pen stroke metadata and wherein the metadata storage device is attached to the predefined area of the document.

Regarding claim 7, Applicants respectfully submit that Lapstun '045 does not teach or suggest storing biometric metadata on the document.

Regarding claim 13, Applicants respectfully submit that Lapstun '045 does not teach or suggest deciding when to stop capturing metadata.

Regarding claim 14, Applicants respectfully submit that Lapstun '045 does not teach or suggest a subset of the metadata data.

Regarding claim 15, Applicants respectfully submit that the cited references do not teach or suggest:

then storing the processed metadata in the dynamic read-write metadata storage device that is completely attached to a portion of a surface of the document.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1-3 and 5-17.

In section 5 of the Office Action, the Examiner rejected Claim 4 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,681,045 B1 to Lapstun, et al. ("Lapstun '045") and U.S. Patent No. 6,773,177 to Denoue, et al. ("Denoue '177") in view U.S. Patent No. 6,795,060 to Rekimoto, et al. ("Rekimoto '060").

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Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended claims 1 and 4 and the rejection is moot.

Applicants respectfully submit that claim 4 is patentable over the cited references for at least the reasons cited above with reference to claims 1-2.

Furthermore, Applicants respectfully submit that the cited references do not teach or suggest:

wherein a transceiver within the digital pen is utilized to program the dynamic read-write metadata storage device and wherein the digital pen is brought into proximity of the rf-id tag during the programming.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claim 4.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-17 is patentable and in condition for allowance.

### **3. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

### **4. Authorization**

No fee is believed due with this Amendment other than that associated with the enclosed petition for extension of time to respond. However, the Commissioner

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is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-522.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-522.

Respectfully submitted,



George M. Macdonald  
Reg. No. 39,284  
Attorney of Record  
Telephone (203) 924-3180

PITNEY BOWES INC.  
Intellectual Property and Technology Law Department  
35 Waterview Drive, P.O. Box 3000  
Shelton, CT 06484-8000